

REMARKS

Reconsideration and withdrawal of the rejections of the application are requested in view of the following remarks.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-39, 41 and 42 are pending in this application. Claims 18-38 and 42 are withdrawn from consideration.

Applicant respectfully submits herewith a Declaration by Richard Bryan Jotcham under 35 C.F.R. §1.132. Reconsideration and withdrawal of the rejections of the application are requested in view of the remarks and exhibit presented herein.

II. REJECTIONS UNDER 35 U.S.C. § 103

Initially, Applicant submits that establishing a *prima facie* case of obviousness requires that the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143. Further, in order to ground an obviousness rejection, there must be some teaching which would have provided the necessary incentive or motivation for modifying the reference's teachings. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (BOPAI 1993). As stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): "The mere fact that the prior art may be modified in the manner suggested by the Office Action does not make the modification obvious unless the prior art suggests the desirability of the modification." Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicant's disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Furthermore, the Supreme Court has recently reaffirmed the factors set out in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18: "[T]he scope and content of the prior art are determined; differences between the prior art and the claims at issue are...ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances

surrounding the origin of the subject matter sought to be patented.” *KSR International Co. v. Teleflex Inc.*, 550 U.S. ____ (2007).

Section 103 over Kurrle and Boehm

Claims 1, 2, 4, 7-9, 12, 13, 15, 17, 39, and 41 were rejected under Section 103(a) as allegedly being unpatentable over U.S. Patent No. 6,054,021 to Kurrle et al. (“Kurrle”) in view of Boehm (U.S. Patent No. 4,897,300). This rejection is traversed at least for the following reasons.

Instant claim 1 recites:

“A security fibre **made of paper, said fibre having a front side, a rear side, a length, and a width**, wherein a plurality of regions are printed on said front and rear sides of said fibre, wherein said regions are coloured and the colours are visible only under ultra-violet light, whereby the fibre is suitable for mixing with slurry paper pulp for paper formation.” (Emphasis added)

Accordingly, one embodiment of the instant invention relates to a security fibre made of paper. The fibre has a front side, a rear side, a length, and a width, and a plurality of regions are printed on the front and rear sides of the fibre.

Applicant respectfully submits that since the above claimed features breathe life and meaning into the claim and define the structure of the instant security fibre, it would be improper to ignore the claimed features when construing the claims of the present application.

In the Final Office Action mailed on May 24, 2010, the Examiner relied upon Kurrle to teach fibers made of paper that can be included in paper slurry for paper formation. The Examiner contends that it would have been obvious to one of ordinary skill in the art at the time of the invention to print the paper fibers of Kurrle in the manner taught by Boehm motivated by the desire to increase the difficulty in counterfeiting the security document. Applicant respectfully disagrees.

As evidenced by the expert declaration by Richard Bryan Jotcham, the component furnish fibres described by Kurrle have a typical facial area of 0.018mm^2 ; whereas a typical security fibre has a facial area of almost 10 times this at 0.12mm^2 ; thus, the Examiner is ignoring the fact that printing component furnish fibres of this size with a plurality of colours would be technically impossible. It would not be possible to distinguish between the colours on such a thin fibre (See Declaration, #30).

Additionally, security threads are almost exclusively made from continuous polyester, which explains why Boehm does not refer to fibres. Anyone skilled in the art of security threads and inclusions would not confuse these terms. In other words, the threads disclosed in Boehm are not made and cannot be made from the fibres disclosed in Kurrle (See Declaration, #29).

Kurrle describes the impregnation or saturation of furnish fibres with fluorescent whitening agents. These are then dispersed and added to furnish during papermaking. Instant claim 1 recites, *inter alia*, ‘a security fibre made of paper’. The Oxford Dictionary defines paper as a ‘material manufactured in thin sheets from the pulp of wood or other fibrous substances’. Clearly, Kurrle involves discrete furnish fibres whereas the instantly claimed security fibre involves the use of paper (See Declaration, #33).

Instant claim 1 also recites, *inter alia*, ‘a plurality of regions printed on said front and rear of said fibres’. Applicant respectfully submit that it is technically impossible to print a plurality of regions on individual furnish fibres, which is why Kurrle does not refer to printing but describes a coating or saturation process (See Declaration, #34).

Similarly claim 39 refers to ‘a fibre made of paper... wherein a plurality of regions have print ...’ Printing more than one colour on a discrete fibre is technically impossible, particularly as the saturation process described by Kurrle involves a mat of component fibres in a random distribution making it impossible to create a plurality of colours on each fibre (See Declaration, #35).

Furthermore, there is no suggestion in Kurrle to use different colors on the same fiber. Throughout its disclosure, Kurrle teaches using a Fluorescent Whitening Agent (FWA). There is no suggestion in Kurrle for using a plurality of regions printed on the front and rear sides of the fiber in a plurality of colors.

Referring to claim 41, the Oxford Dictionary defines plural as ‘more than one in number’. The process of coating or saturation described by Kurrle specifically describes a single application of fluorescent whitening agent. It would not be obvious to anyone reading this patent that more than one colour could be applied that would encompass all of the component fibres or how this could be achieved using Kurrle’s technique (See Declaration, #36).

For at least the foregoing reasons, neither Kurrle nor Boehm, taken alone or in combination, render instant claim 1 obvious. Specifically, the combination fails to teach or suggest security fibre made of paper, said fibre having a front side, a rear side, a length, and a width, wherein a plurality of

regions are printed on said front and rear sides of said fibre, wherein said regions are coloured and the colours are visible only under ultra-violet light, whereby the fibre is suitable for mixing with slurry paper pulp for paper formation, as recited in instant claim 1, and similar recitations in claims 39 and 41 (See Declaration, #39).

Independent claim 1 is therefore patentable over the combination of Kurrle and Boehm and claims 2, 4, 7-9, 12, 13, 15, 17, 39, and 41 are patentable over Kurrle and Boehm at least by virtue of their dependence on claim 1. Modified claims 39 and 41 are patentable over Kurrle and Boehm for similar reasons *mutatis mutandis* as those above.

III. DEPENDENT CLAIMS

Section 103 over Kurrle in view of Boehm and further in view of Kaule.

Claims 3-6, 10, 11, and 14 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Kurrle in view of Boehm, and further in view of U.S. Patent No. 4,756,557 to Kaule et al. (“Kaule”). This rejection is traversed.

Applicant respectfully submits that Kaule relates to a security thread, which is a coextruded multicomponent synthetic thread whose individual components contain additives such as dyes or fluorescent substances and/or particles having electrical or magnetic properties, which is clearly very different from security fibres made of paper. Kaule does not supply the teaching that is lacking in Kurrle and Boehm as discussed above and claims 3-6, 10, 11, and 14 are therefore patentable at least by virtue of their dependence on claim 1.

Therefore, the combination of Kurrle, Boehm and Kaule fails to render claims 3-6, 10, 11, and 14 obvious.

Section 103 over Kurrle in view of Boehm and further in view of Haslop

Claim 16 was under 35 U.S.C. §103(a) as allegedly being unpatentable over Kurrle in view of Boehm and further in view of U.S. Patent No. 5,447,335 to Haslop (“Haslop”). This rejection is traversed.

Applicant respectfully submits that Haslop relates to an authenticatable item and security device that carry a number of symbols identifiable to the naked eye. Haslop does not supply the teaching that is lacking in Kurrle and Boehm as discussed above and claim 16 is therefore patentable at least by virtue of its dependence on claim 1.

Therefore, the combination of Kurrle, Boehm and Haslop fails to render claim 16 as obvious.

For at least the reasons provided herewith, none of the cited references render the instant claims as unpatentable. Accordingly, reconsideration and withdrawal of all Section 103 rejections are requested.

Applicant maintains that all claims are allowable for at least the reasons presented hereinabove, and in the interests of brevity, this response does not comment on each and every comment made by the Examiner in the action. This should, however, not be taken as acquiescence of the substance of those comments, and Applicant reserves the right to address such comments.

CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that all of the claims in this application are patentable and Applicant respectfully requests early passage to issue of the present application.

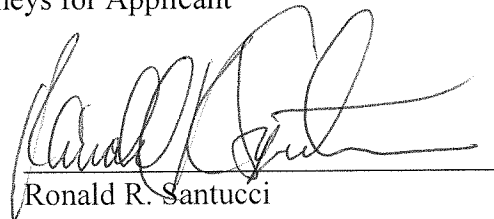
In the event the Examiner disagrees with any of statements appearing above with respect to the disclosures in the cited references, it is respectfully requested that the Examiner specifically indicate that portion, or portions, of the reference(s) providing the basis for a contrary view.

The Commissioner is authorized to charge any fee that may be required to Deposit Account No. 50-0320.

Respectfully submitted,

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